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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/004,129

11/01/2001

Gary K. Weise

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7590

10/19/2004

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EXAMINER

PATEL, DHIRUBHAI R

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,129

Applicant(s)

WEISE ET AL.

Examiner

DHIRU R PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26,28-31,33-38 and 40-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-8,13,14,18,23,24,26,28-31,33-35 and 46-52 is/are allowed.
- 6) ☒ Claim(s) 1-3,9-12,15-17,19-22,25,36-38,40 and 41 is/are rejected.
- 7) ☒ Claim(s) 42-45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a spacer member recited in claim 42 must be shown or the feature(s) canceled from the claim(s). A proposed drawing correction or corrected drawings are required in reply to the office action to avoid abandonment of the application. The objection to the drawings will not be held in **abeyance**.

No new matter should be entered.

Applicant is responsible for showing reference number for each claimed invention.

2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 36 is rejected under 35 U.S.C. § 102(b) as being anticipated by Nichols (4,151,363).

Nichols discloses :

Regarding claim 36, a unitary insert member 16 for use in combination with an electrical junction box 10 (see fig 1), said insert member including an axially extending cylindrical body portion 14 of selected configuration in axial end view (see fig 1), and at least one boss member (18, 20, 22 and 24) extending from said body portion (see fig 1), said body portion and said boss member cooperatively defining a stepped axial through bore 15 with a larger diameter portion 36 opening outwardly on said boss member (see fig 1) and a small diameter portion opening on said body portion (see fig 1), and cooperating with said larger diameter portion to define a shoulder 52 (see column 2, line 12) on said through bore disposed toward said larger diameter portion, with respect to said stepped through bore providing a socket for receiving into said larger diameter portion an end portion of an electrical conduit (it is noted that the assembly of Nichols meet the structural limitations, see fig 1).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3, 9-12, 15-17, 19-22, and 25 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over L. E. Palmer (2,959,633)

Palmer et al disclose:

Regarding claims 1 and 9, a high-volume, high-utility, non-conductive enclosure for electrical components and wiring comprising: a molded polymer junction box 10 (see fig 1, column 2 lines 15-20) including a back wall 11, and plural non-perforate contiguous walls 12, 13

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extending generally perpendicularly to said back wall (see fig 1, and entire column 2 and element number 15), and each one of said plural contiguous walls joining integrally to the back wall and also to adjacent ones of said plural contiguous walls (see fig 1), said back wall and said plural contiguous walls cooperatively defining a chamber within said junction box (see fig 1), with said plural contiguous walls at respective end edges cooperatively forming an opening to said chamber (see fig 1), at least one of said plural contiguous walls carrying an integral mounting lug member 20 extending across said opening (see fig 1), and said mounting lug member also extending inwardly of said chamber from substantially said end edge of said at least one wall toward but short of said back wall to define a termination surface (see fig 1), whereby an electrical component may be inserted via said opening into said chamber to be secured within the junction box at said mounting lug (see fig1), but fails to disclose a non-perforate back wall for claim 1. Please note that palmer teach the use of plural non- perforate contiguous walls 12, 13 extending generally perpendicularly to said back wall (see fig 1, and entire column 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a non-perforate said back wall, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

With respect to claim 9, see fig 1.

Regarding claim 2, the modified assembly of Palmer shows all of the claimed features as shown above, including said one wall defines a wall portion extending a from said termination

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surface to said back wall, whereby said wall portion provides a wall surface within said junction box for receiving a conduit socket (see fig 2).

Regarding claim 3, the modified assembly of Palmer shows all of the claimed features as shown above, including at least a selected one of said plural contiguous walls carries on an outer surface thereof a drilling indicia for positioning a conduit socket (see figs 5 and 7, and entire column 3) .

Regarding claims 10-12, the modified assembly of Palmer shows all of the claimed features as shown above, but fails to disclose Plural mounting lugs integrally joining with said at least one wall and each lug is independent of each other mounting lug. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any number of mounting lugs, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 15, a molded non-conductive plastic junction box 10 (see entire column 2) comprising a back wall 22 and four contiguous non-perforate integral side walls 12,13, each joined both to the back wall and to two adjacent ones of the four contiguous side walls, said four contiguous side walls being disposed in spaced apart opposite pairs (see fig 1, and entire column 2, and element number 15), said back wall and four side walls cooperatively bounding a chamber within said junction box (see fig 1), and each side wall terminating at an end edge substantially in a common plane to cooperatively define an opening to said chamber (see fig 1), and one of said four contiguous side walls carrying an integral mounting lug 20

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extending from said one side wall toward the opposite one of said side walls (see fig 1), said mounting lug also extending from substantially said common plane toward but short of said back wall (see fig 1), and said one wall providing a wall portion extending from said mounting lug to said back wall which is unobstructed and available for mounting of a conduit socket therein (see fig 1), whereby said junction box provides increased interior volume and increased wall area for the mounting of conduit sockets (see fig 1), but fails to disclose a non-perforate back wall. Please note that palmer teach the use of plural non-perforate contiguous walls 12, 13 extending generally perpendicularly to said back wall (see fig 1, and entire column 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a non-perforate said back wall, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With respect to claims 16-17, Please note that the modified assembly of Palmer et al meet the structural limitations and capable of functioning as claimed (see fig 2).

Regarding claim 19, the modified assembly of Palmer shows all of the claimed features as shown above, including said mounting lug cantilevers from said one of said four side walls (see fig 1).

Regarding claim 20, the modified assembly of Palmer shows all of the claimed features as shown above, but fails to disclose said one side wall carries plural mounting lugs integrally joining with said one side wall. Please note that palmer teaches the use of a mounting lugs integrally joining with said one side wall (see fig 1). It would have been obvious to one having

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ordinary skill in the art at the time the invention was made to provide any number of mounting lugs, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 21-22, the modified assembly of Palmer shows all of the claimed features as shown above. It is noted that the modified assembly of Palmer meet the structural limitations.

Claim 25 is method counter part of product claim 1.

5. Claims 37-38 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Nichols (4,151,363)

Nichols discloses:

Regarding claim 37, the assembly of Nichols disclose all the features as shown above, but fails to disclose said insert member provides a pair of boss members and a corresponding pair of conduit sockets in side by side relationship. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any number of boss members, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Regarding claim 38, the assembly of Nichols disclose all the features as shown above, including said body portion has an axial center line in side elevation view, and said boss portion similarly has a center line in side elevation view, and the respective axial centerlines

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of said body portion and of said boss member being in a selected relationship to one another (see fig 1).

6. Claims 40-41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over F. E. Wentworth (2,393,581).

F. E. Wentworth discloses;

Regarding claim 40, an insert member 19 (see fig 1) for use in combination with a pair of electrical junction boxes 29, 31 (see fig 1), each of which defines a respective one of a pair of outwardly opening insert recesses 15,17 (see fig 1) said insert member providing for joining of said pair of electrical junction box to form a ganged pair of junction boxes, said insert member including a central body portion (see fig 1), and a pair of boss members 21 matching in size and shape with said pair of insert recesses (see fig 1) and extending in opposite directions from said body portion, said body portion and said pair boss members cooperatively defining a through passage opening outwardly on each of said pair of boss members and extending axially through said insert member, whereby each one of said pair of boss members is received into a respective insert recess of said pair of junction boxes to form a ganged pair of junction boxes (see fig 1), but fails to disclose said opening insert recesses being rectangular shape, and each said boss member being rectangular. It would have been obvious to one having ordinary skill in the art at the invention was made to provide the assembly of F. E. Wentworth with said opening insert recesses being rectangular shape, and each said boss member being rectangular, since more than a mere change of form is necessary for patentability. In re Span-deck Inc. V. Fab-con, Inc.(CA 8, 1982) 215 USPQ 835.

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Regarding claim 41, it is noted that the modified assembly of F. E. Wentworth meet the structural limitations.

Allowable Subject Matter

- 46 28 10/16/04
7. Claims 4-8, 13-14, 18, 23-24, 26, 28-30, 31, 33-35, ~~48~~ -52 are allowed.
 8. Claims 42-45 would be allowable if overcome the drawing objection set forth in this office action.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reasons for the indication of the allowability of claims 4-8, 13-14, 18, 23-24, 26, 28-30, 31, 33-35, 42 -52 are the inclusion therein, in combination as currently claimed, of the limitation of each one of said plural drilling indicia are spaced from an adjacent drilling indicia by twice said determined distance (for claim 4) ,said nut member engages one or more of said inner wall surfaces and another nut member to substantially prevent said nut member from rotating when a conduit socket member is tightened into said nut member (for claims 5-8), said web member has a pair of opposite ends, and said web member further joins integrally at each of its opposite ends with respective ones of said plural contiguous walls (For claims 13-14), said nut member engages one or more of said inner side wall surfaces and another adjacent nut member to substantially prevent said nut member from rotating when a conduit socket member is tightened into said nut member (for claim 18), further including an elongate web member extending transversely of said junction box, and said web member integrally joining with each of said plural mounting lugs

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on said one side wall (for claims 23-24), said insert recess having an outer portion of a larger size opening outwardly on said junction box and an inner portion of a smaller size opening unwardly to said volume (for claim 26, 28-30, 31, 33-35), said conduit coupling further including provision for receiving and retaining a spacer member disposed between said exterior boss and a surface upon which said conduit coupling is attached (for claims 42-45), each corner recess including a recess floor bounded by a pair of recess side walls which insert with the floor (for claims 46-47, 50-51), said mounting member includes an elongate tab member received into a corner recess and upon said mounting pin, said tab member defining a locating hole received over said mounting pin, and plural end edge surfaces disposed about said locating hole and which intersect at 45 degree angles to one another and to the length of said elongate mounting tab (for claim 48), said mounting tab being elongate and including three end edge surfaces each disposed at an effective angle of 45 degrees relative to the adjacent end edge surface (For claim 49) and providing said tab member with plural end edge surfaces disposed about said locating hole and which intersect at 45 degree angles to one another and to the length of said elongate mounting tab, whereby said mounting tab may be adhesively secured into said corner recess in any one of three alternative positions each disposed at 45 degrees to the other (for claim 52).

The previously listed limitation is neither disclosed nor taught by the prior art of record, alone or in combination.

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9. **Contact information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhiru Patel whose telephone number is 571-272-1983. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Dhiru Patel
Primary Examiner
Group Art Unit 2831
October 16, 2004


DHIRU R. PATEL
PRIMARY EXAMINER
10/16/04.